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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,771	02/05/2002	Charles Eldering	T742-10	7576

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EXPANSE NETWORKS, INC.  
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EXAMINER

HUYNH, SON P

ART UNIT PAPER NUMBER

2611

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/068,771

Applicant(s)

ELDERING ET AL.

Examiner

Son P Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 154-171 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 154-171 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/19/03; 4/5/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The previous Final Office Action has been withdrawn in view of the new ground(s) of rejection.

Claims 1-153 and 172-193 have been cancelled.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 154-171 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (US 6,463,585), and in view of Hite et al. (US 5,774,170); and further in view of Maissel et al. (US 2003/0088872).

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Regarding claim 154, Hendricks discloses a method for delivering targeted advertisements to a subscriber with video that the subscriber selected to receive from a television delivery system (col. 3, line 48-col. 4, line 5), the method comprising: selecting the video (selecting a program carried in program channel – col. 9, lines 5-20, col. 17, lines 15-35);

determining available advertisement opportunities in the selected video (determining “pods” in the program – col. 5, lines 30-60, col. 27, lines 16-38); receiving advertisement profiles, wherein the advertisement define advertisement trails and intended market trails for an associated advertisement (Hendricks discloses targeted advertisement can be assigned to program breaks based on program breaks that occur in a particular program, based on program categories, based on specific program-col. 27, lines 39-61, based on specific user and specific demographic and geographic- col. 26, lines 42-67. Inherently, the advertisement profile must be received, and the advertisement profile must define advertisement trails (associated to specific program, program categories) and intended market trails (e.g. information identifies the advertisement for particular demographic and geographic)).

selecting a first set of advertisements capable of being delivered with the video by comparing the advertisement traits and the available advertisement opportunities (selecting advertisement based on break timing and feeder channel availability-col. 27, lines 40-62);

selecting a second set of advertisements that are of interest to a subscriber by comparing the intended target market trails and some combination of a subscriber

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profile that define trails associated with the subscriber, household demographics, trails associated with the selected video, or trails associated with previously selected video (selecting targeted advertisement based on information known about the demographics and viewing habits of users of the set top terminals, specific geographic, specific program, etc. – col. 26, line 14-col. 27, line 67); s

selecting targeted advertisements, wherein the targeted advertisements include a subset of advertisements that are part of both the first set of advertisements and the second set of advertisement (selecting targeted advertisements based on break timing, feeder channel availability, user demographic and user geographic (col. 26, line 14-col. 27, line 67); delivering the selected video and the targeted advertisements to the subscriber (col. 26, line 14-col. 27, line 67);

presenting the selected video and the targeted advertisement to the subscriber on a viewing device (displaying selected program and displaying targeted advertisement during program break – col. 15, line 60-col. 16, line 12). Hendricks further discloses presenting alternative advertisement (col. 26, lines 14-30). However, Hendricks does not specifically discloses presenting an alternative advertisement when the subscriber fast forward or skips the targeted advertisement, and wherein the alternative advertisement is a shortened version of the targeted advertisement.

Maissel teaches presenting an alternative advertisement when the subscriber fast-forwards the targeted advertisement (commercial), and wherein the alternative advertisement is a shortened version of the targeted advertisement (par. 0394).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks to use the teaching as taught by Maissel in order to prevent user to avoid watching advertisement thereby improve efficiency in advertising.

Regarding claim 155, Hendricks in view of Maissel teaches the method as discussed in the rejection of claim 154. Maissel further teaches the advertisements traits includes parameters defining limits on presentation of the associated advertisement to the subscriber (par. 0309, par. 0378 – par. 0386), and comprising: monitoring advertisements presented to the subscriber; and confirming that the selected targeted advertising are within the limits defined in the advertisement traits based on the monitoring (the commercial may be deleted after the user has seen it a predetermined number of times – par. 0388-0389).

Regarding claims 156-161, Hendricks in view of Maissel teaches a method as discussed in the rejection of claim 154. Hendricks further discloses the programmer with assistance from the CAP, controls the delivery and displaying of targeted advertisements and programs (col. 11, line 55-col. 12, line 9; col. 48, line 65-col. 51, line 25). Obviously, the available advertisement opportunities may be prior to, during, within or after the video, delivering the targeted advertisements prepended to the video or postpended to the video or between different segments of the video or as part of the video according to the advertisement opportunities, wherein the advertisement

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opportunities within the video include at least some subset of bugs, product placements, overlays, and banners in order to achieve programmer's desire.

Regarding claim 162, Maissel teaches the alternative advertisement is presented in place of the targeted advertisement (par. 0394).

Regarding claim 163, Hendricks in view of Maissel teaches a method as discussed in the rejection of claim 154. Maissel further discloses that during fast-forward and fast backward through the commercial, a shortened version is displayed (par. 0394).

Therefore, the presenting of shortened version when fast-forward the program reads on the claimed limitation of "the alternative advertisement is presented in conjunction with the targeted advertisement."

Regarding claim 164, Hendricks in view of Maissel teaches a method as discussed in the rejection of claim 154. Maissel further teaches the alternative advertisement is derived from the targeted advertisement by application of processing rules (e.g. displaying shortened version when the full version of commercial is fast-forwarded – par. 0394).

Regarding claim 165, Hendricks in view Maissel teaches a method as discussed in the rejection of claim 154. Maissel further teaches the alternative advertisement is a

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separate advertisement (shortened version) related to the targeted advertisement (full version – par. 0394).

Regarding claims 166-169, the limitations of the system as claimed correspond to the limitations of the methods as claimed in claims 154, 162-164 respectively, and are analyzed as discussed with respect to the rejection of claims 154, 162-164.

Regarding claims 170 -171, the limitations as claimed directed toward embodying the method of claims 154, 164 in “computer readable medium”. It would have been obvious to embody the procedures of Hendricks in view of Maissel as discussed with respect to claim 154, 164 in a “computer readable medium” in order that the instructions could be automatically performed by a processor.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dimitrova et al. (US 6,100,941) teaches apparatus and method for locating a commercial disposed within a video data stream.

Hoyle (US 6,141,010) teaches computer interface method and apparatus with targeted advertising.



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Berberet et al. (US 2003/0226150) teaches system and method for providing broadcast programming, a virtual VCR, and a video scrapbook to programming subscribers.

Slezak (US 6,006,257) teaches multimedia architecture for interactive advertising in which secondary programming is varied based upon viewer demographics and content of primary programming.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C Grant can be reached on 703-305-4755. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son P. Huynh  
November 12, 2004

  
CHRIS GRANT  
PRIMARY EXAMINER